

REMARKS

The Office examined claims 1-37 and issued a restriction requirement, forcing applicant to elect either:

- I. claims 1-9 and 28-29 (Group I) to a method or computer program product;
- II. claims 10-18, 26, 30, and 32-34 to a UE (Group II); or
- III. claims 19-25, 27, 31, and 35-37 to a Node B (Group III).

With this paper, an election is made, as required, but with traverse. In addition, *new claims 38-43 are added to the application*. Thus, the application now includes claims 1-43.

Election

Applicant hereby elects Group I for examination, but with traverse.

Further, new system claim 42 recites limitations corresponding to those of claim 1, and so ought to also be included in elected Group I. Further still, new system claim 43 depends from new claim 42, and so ought to also be included in elected Group I.

In addition, applicant submits that since new method claim 38 recites limitations corresponding to all the limitations of UE Group II claim 10 (or claim 32), and so ought to be included in Group II. See MPEP 806.05(c)(I). Also, new claim 39 depends from claim 38 and so ought also be included in Group II.

Finally, new method claim 40 recites limitations corresponding to the limitations of Node B Group III claim 19 (or claim 35), and so ought to be included in Group III. See MPEP 806.05(c)(I). Also, new claim 41 depends from claim 40 and so ought also be including in Group III.

Traversal of the restriction requirement

The authority for the Office to issue a restriction requirement derives from 35 USC §121, which provides that:

If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions. [Emphasis added.]

Applicant's attorney understands that despite the recitation by 35 USC §121 of "independent and distinct," the Office considers restriction proper where inventions can be asserted as either independent or distinct, where these two terms have a particular meaning asserted by the Office. (See MPEP § 803.)

The MPEP at § 802.01 defines "independent" as follows:

The term "independent" (i.e., unrelated) means that there is no disclosed relationship between the two or more inventions claimed, that is, they are unconnected in design, operation, and effect. For example, a process and an apparatus incapable of being used in practicing the process are independent inventions.

At that same section, the MPEP provides a definition for "distinct" as follows:

Related inventions are distinct if the inventions as claimed are not connected in at least one of design, operation, or effect (e.g., can be made by, or used in, a materially different process) and wherein at least one invention is PATENTABLE (novel and nonobvious) OVER THE OTHER (though they may each be unpatentable over the prior art).

The invention solves a problem encountered during a soft handover. In a soft handover, a user equipment (UE) is handed over from a first Node B to another Node B, and during this, is in contact with both, i.e. both receive all communications from the user equipment, and in the prior art, both issue so-called scheduling commands, which, among other things, regulate the maximum allowed power the UE is allowed to use in uplink. The

power regulation is done by sending commands that set the value of a pointer so as to indicate one or another maximum allowed power rate. So in the prior art, a UE could receive scheduling commands from each of the two Node Bs involved in a handover, and the commands could be inconsistent.

The invention solves this problem by having a UE transmit to both Node Bs information indicating which is to be the controlling Node B, and so which is to provide scheduling commands. The information is recited as information indicating which of the two cells involved in the handover is to be the scheduling cell. The Node Bs know which of them controls which cell, and so can tell from the information which of them is to be the controlling Node B.

All Group II claims (to a UE) recite a UE signaling in uplink information indicating a particular cell as a scheduling cell, and all Group III claims (to a Node B) recite a Node B receiving the uplink and determining whether it is in control of the scheduling cell, and issuing scheduling commands for controlling the pointer in the UE if it is in control, but issuing no such commands if it determines it is not in control of the scheduling cell.

Thus, a UE according to the (Group II) claims is of no utility without a Node B according to the (Group III) claims, and *vice versa*.

Therefore, a UE according to the claims cannot be said to be term "independent" (i.e., unrelated) of a Node B according to the claims, because there is in fact a disclosed relationship between the two, that is, they are connected in design, operation, and effect. A Node B would only receive information indicating a scheduling cell and act on it if there were a UE configured to provide such information. Conversely, a UE would only provide such information if the Node Bs that would receive the

information were configured to use the information to determine which of them is to provide scheduling commands.

And a UE according to the claims cannot be said to be term "distinct" from a Node B according to the claims because they are in fact connected in at least one of design, operation, or effect and wherein at least one invention is not patentable (novel and nonobvious) over the other (though they may each be unpatentable over the prior art). The claimed UE is designed and operates to provide information that affects the operation of a claimed Node B in that it causes the Node B to inspect the information and determine from it whether to issue scheduling commands. Conversely, the claimed Node B is designed and operates to use information provided by a UE to determine whether it is to issue scheduling commands to the UE.

Further, the claimed UE suggests the claimed Node B: a UE operating according to the invention and so providing uplink information indicating a scheduling cell suggests a Node B acting on such information. Conversely, the claimed Node B suggests the claimed UE: a Node B examining uplink information indicating a scheduling cell suggests a UE providing such information. Thus, neither is patentable over the other. The claimed UE and claimed Node B stand in the same relation to each other as a specially threaded bolt does to a correspondingly specially threaded nut.

Thus, the invention as in the Group III claims (to a Node B) is neither independent nor distinct from the invention as in the Group II claims (to a UE), as the terms "independent" and "distinct" are defined by the Office.

Regarding the Group I claims, elected for examination by this paper, these claims recite both a UE signaling in uplink information indicating a particular cell as a scheduling cell, and a Node B receiving the uplink and determining whether it is in control of the scheduling cell, and issuing scheduling

commands for controlling the pointer in the UE if it is in control, but issuing no such commands if it determines it is not in control of the scheduling cell. In other words, the Group I claims include the limitations of both the Group II claims and also the Group III claims. It cannot therefore be asserted that the Group I claims are either independent or distinct from the Group II claims or the Group III claims, neither of which are either independent or distinct from each other, for the reasons given above, and so are not properly restrictable.

Further, the MPEP at 806.05(d) provides that:

To support a restriction requirement where applicant separately claims plural subcombinations usable together in a single combination and claims a combination that requires the particulars of at least one of said subcombinations, both two-way distinctness and reasons for insisting on restriction are necessary. Each subcombination is distinct from the combination as claimed if:

(A) the combination does not require the particulars of the subcombination as claimed for patentability (e.g., to show novelty and unobviousness), and

(B) the subcombination can be shown to have utility either by itself or in another materially different combination. See MPEP § 806.05(c). Furthermore, restriction is only proper when there would be a serious burden if restriction were not required, as evidenced by separate classification, status, or field of search.

In the matter at hand, the Group I claims are to a combination that includes the particulars of the subcombination Group II and also the subcombination Group III. Applicant respectfully asserts that regardless of whether prong (A) of the test passes or fails for restriction, the Group II subcombination has no utility by itself or in another materially different combination, nor does the Group III subcombination. The Office has asserted that "subcombination I has separate utility such as permitting communication between a mobile station and a base station," but

Group I is not a subcombination, so this assertion by the Office is nonsensical, in that what is required is that a subcombination have separate utility from its use in a combination, and there is not combination of which Group I is a subcombination. The Office next asserts that "subcombination II has separate utility such as a mobile station for providing communication to a user," but the separate utility required for restriction must be utility for the subcombination including all recited particulars, and all subcombination II claims include:

uplinking information indicating as a scheduling cell a particular cell from among a plurality of cells involved in a soft handover, each cell possibly controlled by a different Node B,

and as argued above, the only utility of such a particular is as in the combination (Group I). The Office next asserts that "subcombination III has separate utility such as a base station for communicating between a radio access network and mobile stations," but again, the separate utility required for restriction must be utility for the subcombination including all recited particulars, and all subcombination III claims include:

determining when to assume control of scheduling of the user equipment device and when to cease control of scheduling of the user equipment device based on information uplinked by the user equipment device indicating as a scheduling cell a particular cell from among a plurality of cells involved in a soft handover,

and as argued above, the only utility of such a particular is as in the combination (Group I).

Further in regard to prong (A) of the test for restriction, the combination requires the particulars of either the subcombination I as claimed for patentability, or the subcombination III as claimed for patentability, and so there can not be a restriction as set out in the Office action, i.e. a restriction to either Group I (a combination, including the

specific particulars of Group II and also the specific particulars of Group III), or Group II or Group III. (See MPEP at 806.05(c)(I).)

Further in regard to the restriction requirement generally: applicant respectfully submits that it is the policy of the Office not to require restriction unless one or more of three reasons appear: a separate classification, a separate status in the art, and a different field of search. (See MPEP § 808.02 and also 806.05(d).) Despite the assertion by the Examiner that "the inventions have acquired a separate status in the art in view of their different classification," the classification (not sub-classification) for each is class 370, and applicant respectfully submits that in searching for a method as in Group I the Examiner would search the same art when searching for a UE as in the Group II or a Node B as in Group III, for the reasons given above, i.e. that the Group I claims include the limitations of both Group II and Group III.

Conclusion

It is believed that all of the claims of the application are in condition for allowance and their passage to issue is earnestly solicited. Applicant's attorney urges the Examiner to call to discuss the present response if anything in the present response is unclear or unpersuasive.

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Date

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